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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,800	06/30/2000	Chandrasekhar Narayanaswami	13576 (YOR9-2000-0226)	1158

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EXAMINER

TRAN, HENRY N

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/607,800

Applicant(s)

NARAYANASWAMI,  
CHANDRASEKHAR

Examiner

HENRY N. TRAN

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16, 19, 20, 22, 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18, 21, 23, 24 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 June 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office action is in response to the applicant's amendment filed 12/11/02 (Paper No.

6). The amendments to the claims were entered; and the applicant's remarks have been considered, with the results set forth as following.

1. Claims 1 and 2-27 are pending in this application.

#### *Information Disclosure Statement*

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### *Specification*

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The examiner is unable to find the proper antecedent basis for the following claimed limitations: "a control mechanism" and "a mechanism" (in lines 6 and 9 of claim 1, respectively). It is noted that "a control mechanism" is not described in the specification; also, there are a plurality of "mechanism" described in the specification, for example: mechanism in

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the second device (page 2, line 21), data transfer mechanism (page 7, line 28), a roller wheel mechanism (amendment filed 6/17/02, page 3), etc.

The applicant is required to provide the required descriptions for the above claimed limitations.

4. The disclosure is objected to because of the following informalities: The use of a confusing variety of terms for the same thing, for example:

- personalized user preferences (line 4 of claim 1), personalize data (line 3 of claim 16; line 5 of claim 22; and line 17 of page 2 of the specification);
- a first computer device (line 5 of claim 1), a first computing device (line 4 of claim 16, and line 6 of claim 22); and
- a second computer device (line 9 of claim 1), a second computing device (line 8 of claim 16, and line 10 of claim 22); etc.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 3-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed limitation “a control mechanism” is not

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described in the specification. The examiner has read the claim in light of the specification.

However, the examiner is unable to find a clear support for said claimed limitation. It is necessary to define what “a control mechanism” is in order to insure certainty in construing the claims in light of the specification (see MPEP 608.01(o)).

7. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is noted that claim 3 comprises three “mechanism”: a control mechanism (line 6 of claim 1), a mechanism (line 9 of claim 1), mechanism (line 2 of claim 3). The claimed element: “said mechanism further restoring said ...from said second device” (lines 5-7 of claim 3) was not described in the specification. The examiner is unclear which “mechanism” is referred to for performing said “restoring” function.

8. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is noted that claim 3 comprises three “mechanism”: a control mechanism (line 6 of claim 1), a mechanism (line 9 of claim 1), mechanism (line 2 of claim 12). The claimed element: “mechanism for receiving sensor... of said pointing device” (lines 2-3 of claim 12) was not described in the specification. The examiner is unclear which “mechanism” is referred to for performing said “receiving” function.

9. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is noted that claim 15 comprises three “mechanism”: a control mechanism (line 6 of claim 1), a mechanism (line 9 of claim 1), mechanism (line 2 of claim 15). The claimed element: “mechanism for recognizing a like application being ... personalize data” (lines 2-4 of claim 15) was not described in the specification. The examiner is unclear which “mechanism” is referred to for performing said “recognizing” function.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1 and 3-15 recite the limitation "a control mechanism" in line 6 of claim 1. There is insufficient antecedent basis for this limitation in the claim. The examiner is unable to find a clear support or antecedent basis in the specification for said claimed limitation.

12. Claim 3 recites the limitation "said second device" in line 3. There is insufficient antecedent basis for this limitation in the claim.

13. Claims 5-9 recite the limitation "said personalized data" in line 3 of claim 5. There is insufficient antecedent basis for this limitation in the claims.

14. Claims 5-9 recite the limitation "said first device" and “said second device” in lines 3 and 4 of claim 5. There are insufficient antecedent basis for these limitations in the claims.

15. Claim 10 recites the limitation "said personal pointing device" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 12 recites the limitation "said second device" in line 5. There is insufficient antecedent basis for this limitation in the claim.

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17. Claims 17-18 recite the limitation "said second device" in line 3 of claim 17, and lines 2, 4, and 5 of claim 18. There is insufficient antecedent basis for this limitation in the claims.

18. Claim 21 recites the limitation "said second device" in line 3. There is insufficient antecedent basis for this limitation in the claims.

19. Claims 23-24 recite the limitation "said second device" in lines 3-4 of claim 23, and lines 2-6 of claim 24. There is insufficient antecedent basis for this limitation in the claims.

20. Claim 27 recites the limitation "said second device" in line 4 of claim 27. There is insufficient antecedent basis for this limitation in the claims.

The applicant is required to review disclosure for providing a clear description for the claimed limitations: "a control mechanism", "mechanism", etc. as discussed above in order to overcome the rejections under 35 U.S.C 112 first and second paragraphs discussed above.

The applicant is also required to review claim languages for consistency of every term used in any of the claims.

The examiner is unable to apply prior art(s) for rejecting the above rejected claims until the rejections under 35 U.S.C 112 first and second paragraphs discussed above are overcome.

***Allowable Subject Matter***

21. Claims 16, 19-20, 22, and 25-26 are allowed.

22. The following is an examiner's statement of reasons for allowance:

The present invention comprises an apparatus and a method for customizing software applications via a mouse device. The closest prior art, Allport (US 6,256,019) shows a similar

device 10 (a controller 10) which also stored personalized user preferences. However, Allport fails to: receiving personalized data from the first computing device, storing said personalized data in a memory provided in said mouse, subsequently transferring said stored personalized data to a like user application executing in a second computing device, and altering said like user application. These distinct features have been specifically defined in the independent claims 16 and 22; and render them allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

23. Applicant's arguments with respect to claims 1 and 3-27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is (703) 308-8410. The examiner can normally be reached on Mon - Fri from 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE, can be reached at (703) 305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231



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**or faxed to:**

**(703) 872-9314 (for technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Technology Center 2600 Customer Service Office Whose telephone  
number is (703) 306-0377.

*Henry N. Tran*

**HENRY N. TRAN**  
Examiner  
Art Unit 2674

hnt  
February 19, 2003